UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,285	11/20/2001	Noboru Konno	F-7179	1073

28107	7590	07/06/2006

JORDAN AND HAMBURG LLP
122 EAST 42ND STREET
SUITE 4000
NEW YORK, NY 10168

EXAMINER
WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 May 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2 and 5-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2 and 5-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of: .

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed March 15, 2006 and Request

for Continued Examination filed May 2, 2006.

2.   Claims 1 and 2 have been amended.

3.   Claims 1, 2, and 5-9 have been examined and are pending with this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter, which the applicant regards as his invention.

4.   Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 1 and 2 recites the limitation "said socialization template" and "said

externalization template" in both claims. There is insufficient antecedent basis for this

limitation in the claim.

The claims are generally narrative and indefinite, failing to conform to current

U.S. practice. They appear to be a literal translation into English from a foreign

document and are replete with grammatical and idiomatic errors. The language recited

in claims 1 and 2, "whereby said first member whereby externalization work of said first

member is evaluated" renders the claim limitation indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1, 2, and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Bromberg et al. (US 6,529,889 B1).

INDEPENDENT:

As per *claim 1*, Bromberg teaches a system for:

supporting knowledge creation and managing knowledge assets (see col.4, lines

2-11) by using four common evaluation templates (see col.25, lines 17-26: *"template for

the re-evaluation"* & lines 64-67), wherein a first member of an organization having a

plurality of members is evaluated according to each of said four evaluation templates

(see col.11, lines 46-47: *"evaluation process"*; col.25, lines 18-22: *"all the data from the

previous evaluation is used as a template for the re-evaluation"*; and col.28, lines 9-12:

"evaluative dimension to occur without restriction");

inputting obtained results from said evaluation templates into a computer (see

col.4, lines 52-56: *"this raw material structured content is then stored in a data*

structure"; col.10, lines 40-43: *"This captured knowledge is then converted into... (SSA),*

which is a standalone personal computer"; and col.38, lines 15-17: *"a means for*

inputting knowledge information"); and

analyzing results to show how said member acts in the actual situation (see

col.4, lines 15-17 & lines 35-43: *"gathers information on physical factors, performance,*

behavior, and capability"; col.10, lines 35-40; and col.19, line 61-col.20, line 5);

said four evaluation templates comprising:

a socialization evaluation template for evaluating a socialization process to

capture tacit knowledge (see col.8, lines 30-32: *"capture the organization and structure*

of the tacit, implicit, and hidden knowledge") inside and outside the organization (see

col.4, lines 15-19: *"without limitation"* and *"specific subject matter"* and col.10, lines 46-

48: *"available to and accessible by anyone who has access to the SSA"*);

said socialization template capturing tacit knowledge of a second member of said

organization (see col.10, lines 35-40: *"The purpose of the present invention is to capture*

the skill, experience,..."), said first member being provided with the tacit knowledge of

said second member (see col.5, lines 16-18 and col.10, lines 46-48: *"Once it is*

converted into SSA, that knowledge can be made available to and accessible by

anyone who has access to the SSA") whereby socialization work of said first member is

evaluated (see col.25, lines 18-22);

an externalization evaluation template for evaluating an externalization process

to express tacit knowledge (see col.8, lines 30-32: *"capture the organization and*

structure of the tacit, implicit, and hidden knowledge") in a comprehensible way and

convert it into explicit knowledge (see col.4, lines 8-11: *"generate narratives and other elements such as graphics and tables"*; and col.11, lines 52-55: *"converted into an end-product that includes narrative generation"*);

said externalization template receiving tacit knowledge from said first member and converting said tacit knowledge into explicit knowledge (see col.4, lines 8-11: *"generate narratives and other elements such as graphics and tables"*; and col.11, lines 52-55: *"converted into an end-product that includes narrative generation"*) whereby said first member whereby externalization work of said first member is evaluated (see col.25, lines 18-22);

a combination evaluation template for evaluating a combination process to relate such explicit knowledge to other pieces of explicit knowledge (see col.13, lines 32-35: *"raw structured content... is combined"* and col.38, lines 20-22: *"combining the hierarchically organized topics"*) inside and outside the organization (see col.4, lines 15-19: *"without limitation"* and *"specific subject matter"* and col.10, lines 46-48: *"available to and accessible by anyone who has access to the SSA"*);

said combination evaluation template relating externalized explicit knowledge received from said first member to other explicit knowledge (see col.13, lines 32-35: *"raw structured content... is combined"* and col.38, lines 20-22: *"combining the hierarchically organized topics"*) by searching an internal knowledge database or superficial knowledge database (see col.8, lines 33-35: *"searchable databases"*; col.25, lines 64-67: *"dynamic form is a template from which all topics... to render the various*

questions"; and col.26, lines 29-31) whereby combination work for said first member is

evaluated (see col.25, lines 18-22); and

an internalization evaluation template for evaluating an internalization process to

convert explicit knowledge into tacit knowledge though practice (see col.4, lines 15-17;

col.5, lines 51-54; col.11, lines 56-65; and col.38, lines 24-26);

said internalization evaluation template converting explicit knowledge from said

first member into tacit knowledge (see col.4, lines 15-17; col.5, lines 51-54; col.11, lines

56-65; and col.38, lines 24-26) whereby internalization work of said first member is

evaluated (see col.25, lines 18-22);

said system further comprising a tacit knowledge expression template (see

col.25, lines 64-67), said tacit knowledge expression template being read and output by

a computer as a reference syntax for expressing tacit knowledge in the externalization

process (see col.6, lines 31-34: *"expressed... as questions"*; col.8, lines 30-32: *"capture*

the organization and structure of the tacit, implicit, and hidden knowledge" ; and col.12,

lines 10-13: *"converted into a format that can be displayed")*;

a glossary for a tacit knowledge expression template in said database, said

glossary being read and output by a computer, terms included in said glossary being

applicable to said tacit knowledge expression template (see col.8, lines 33-35:

"searchable databases"; col.25, lines 64-67: *"dynamic form is a template from which all*

topics... to render the various questions"; and col.26, lines 29-31); and

said glossary, providing terms for responding to inquiries (see col.26, lines 29-31)

so that tacit knowledge is converted into explicit knowledge in a common format (see

col.8, lines 33-36: "searchable" and "include pointers"; col.12, lines 10-13; and col.13, lines 48-54).

Although Bromberg teaches that evaluations are performed using templates (see col.25, lines 18-22), Bromberg does not explicitly teach of the individual evaluation templates. However the various evaluation templates are not functionally distinct. Furthermore, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The evaluations of members are performed regardless of the data. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to evaluate any data (i.e. socialization work, externalization work, combination work, and internalization work) because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per *claim 2*, Bromberg teaches a system for supporting knowledge creation and managing knowledge assets comprising a database (see col.3, lines 49-53 and col.8, lines 8-10) including:

a socialization evaluation template for evaluating a socialization process to
capture tacit knowledge (see col.8, lines 30-32: *"capture the organization and structure
of the tacit, implicit, and hidden knowledge"*) inside and outside the organization (see
col.4, lines 15-19: *"without limitation"* and *"specific subject matter"* and col.10, lines 46-
48: *"available to and accessible by anyone who has access to the SSA"*);

said socialization template capturing tacit knowledge of a second member of said
organization (see col.10, lines 35-40: *"The purpose of the present invention is to capture
the skill, experience,..."*), said first member being provided with the tacit knowledge of
said second member (see col.5, lines 16-18 and col.10, lines 46-48: *"Once it is
converted into SSA, that knowledge can be made available to and accessible by
anyone who has access to the SSA"*) whereby socialization work of said first member is
evaluated (see col.25, lines 18-22);

an externalization evaluation template for evaluating an externalization process
to express tacit knowledge (see col.8, lines 30-32: *"capture the organization and
structure of the tacit, implicit, and hidden knowledge"*) in a comprehensible way and
convert it into explicit knowledge (see col.4, lines 8-11: *"generate narratives and other
elements such as graphics and tables"*; and col.11, lines 52-55: *"converted into an end-
product that includes narrative generation"*);

said externalization template receiving tacit knowledge from said first member
and converting said tacit knowledge into explicit knowledge (see col.4, lines 8-11:
"generate narratives and other elements such as graphics and tables"; and col.11, lines
52-55: *"converted into an end-product that includes narrative generation"*) whereby said

first member whereby externalization work of said first member is evaluated (see col.25, lines 18-22);

a combination evaluation template for evaluating a combination process to relate such explicit knowledge to other pieces of explicit knowledge (see col.13, lines 32-35: *"raw structured content... is combined"* and col.38, lines 20-22: *"combining the hierarchically organized topics"*) inside and outside the organization (see col.4, lines 15-19: *"without limitation"* and *"specific subject matter"* and col.10, lines 46-48: *"available to and accessible by anyone who has access to the SSA"*);

said combination evaluation template relating externalized explicit knowledge received from said first member to other explicit knowledge (see col.13, lines 32-35: *"raw structured content... is combined"* and col.38, lines 20-22: *"combining the hierarchically organized topics"*) by searching an internal knowledge database or superficial knowledge database (see col.8, lines 33-35: *"searchable databases"*; col.25, lines 64-67: *"dynamic form is a template from which all topics... to render the various questions"*; and col.26, lines 29-31) whereby combination work for said first member is evaluated (see col.25, lines 18-22);

an internalization evaluation template for evaluating an internalization process to convert explicit knowledge into tacit knowledge (see col.4, lines 15-17; col.5, lines 51-54; col.11, lines 56-65; and col.38, lines 24-26);

said internalization evaluation template converting explicit knowledge from said first member into tacit knowledge (see col.4, lines 15-17; col.5, lines 51-54; col.11, lines

56-65; and col.38, lines 24-26) whereby internalization work of said first member is

evaluated (see col.25, lines 18-22);

said template being common templates (see col.10, lines 60-63);

a computer for reading and outputting said evaluation templates from said

database (see col.10, lines 40-48);

whereby evaluation results about a member of an organization that are entered

in said template are evaluated and the results of said analysis that represent the actual

situation of how said member works are outputted (see col.10, lines 35-40 and col.20,

lines 6-17);

said system further comprising a tacit knowledge expression template (see

col.25, lines 64-67), said tacit knowledge expression template being read and output by

a computer as a reference syntax for expressing tacit knowledge in the externalization

process (see col.6, lines 31-34: *"expressed... as questions"*; col.8, lines 30-32: *"capture*

the organization and structure of the tacit, implicit, and hidden knowledge" ; and col.12,

lines 10-13: *"converted into a format that can be displayed"*);

a glossary for a tacit knowledge expression template in said database, said

glossary being read and output by a computer, terms included in said glossary being

applicable to said tacit knowledge expression template (see col.8, lines 33-35:

"searchable databases"; col.25, lines 64-67: *"dynamic form is a template from which all*

topics... to render the various questions"; and col.26, lines 29-31); and

said glossary, providing terms for responding to inquiries (see col.26, lines 29-31)

so that tacit knowledge is converted into explicit knowledge in a common format (see

col.8, lines 33-36: "searchable" and "include pointers"; col.12, lines 10-13; and col.13,

lines 48-54).

Although Bromberg teaches that evaluations are performed using templates (see

col.25, lines 18-22), Bromberg does not explicitly teach of the individual evaluation

templates. However the various evaluation templates are not functionally distinct.

Furthermore, these differences are only found in the nonfunctional descriptive material

and are not functionally involved in the steps recited. The evaluations of members are

performed regardless of the data. Thus this descriptive material will not distinguish the

claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d

1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32

USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to evaluate any data (i.e. socialization work,

externalization work, combination work, and internalization work) because such data

does not functionally relate to the steps in the method claimed and because the

subjective interpretation of the data does not patentably distinguish the claimed

invention.

DEPENDENT:

As per *claim 5*, Bromberg further teaches wherein said system automatically

presents a knowledge classification map which indicates inter-relatedness of each said

knowledge, when said explicit knowledge is requested by a computer from said

database which contains knowledge accumulated after the combination process (see col.38, lines 18-19).

As per *claim 6*, Bromberg further teaches wherein a knowledge consultant manages a database (see col.8, lines 33-35) and a customer organization has a computer which enables use of every template by accessing said database through a two-way communication network (see col.24, lines 29-33).

As per *claim 7*, although Bromberg further teaches of a database also containing accumulated intellectual resource data (see col.8, lines 33-35), Bromberg does not explicitly teach wherein such information in the database is gained by making a contract between said knowledge consultant and owner of intellectual property (subjective).

As per *claim 8*, Bromberg further teaches wherein a manager manages a database, one or more organizations acting as a knowledge consultant has a server accessible to said database through a two-way communication network, and a customer organization has a computer that works as a client of said server of said knowledge consultant by accessing thereto through a two-way communication network (see claim 6 rejection above), and said database contains different templates available for said customer through said access to said server (implicit: see col.25, lines 17-26 & 64-67: "dynamic").

As per *claim 9*, Bromberg further teaches wherein a database managed by a manager includes accumulated intellectual property data obtained through making contract between said manager and the owner of said intellectual property (see claim 7 rejection above).

Response to Arguments

6.   Applicant's arguments filed March 15, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "evaluating the actions of one member of an organization against the actions of a another member of the same organization" and "templates of the invention enable it to evaluate how much the member has practiced these processes at work") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Although Bromberg does not explicitly state the various evaluation templates (i.e. socialization, externalization, combination, internalization), Bromberg explicitly teaches the functionalities of each of the templates.
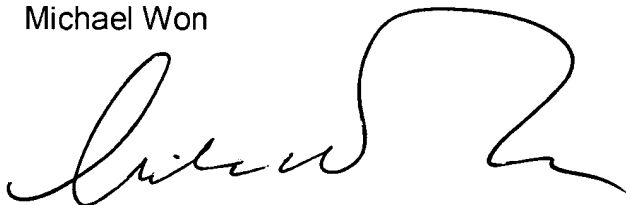
Conclusion

7.   For the reasons and the rejected set for above, claims 1, 2, and 5-9 remain rejected and pending.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Won

June 29, 2006